



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,814	02/20/2004	Steven Markin		7058

7590 08/23/2006

Stephen E. Feldman, P.C.  
12 East 41st Street  
New York, NY 10017

EXAMINER

AHLUWALIA, NAVNEET K

ART UNIT	PAPER NUMBER
----------	--------------

2166

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/783,814	Applicant(s) MARKIN, STEVEN	
	Examiner Navneet K. Ahluwalia	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) 2,3,10,12-14 and 18-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/20/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The application has been examined. Claims 1 – 23 are pending in this office action.

#### ***Claim Objections***

2. Claims 2, 3, 10, 12 – 14 and 18 – 20 are objected to because of the following informalities: Claims 2, 3, 10, 12 – 14 and 18 – 20 recite in the claims abbreviated words like HIPAA, GLBA and CVE. These abbreviated elements need to be explained or stated in full form in the claims. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. ('Williams' herein after) (US 2005/0015623 A1).

With respect to claim 1,

Williams discloses a method for testing compliance of a target comprising the steps of: providing a set of regulations, providing a set of vulnerabilities (figure 1 and paragraph 0052, Williams); providing a mapping relationship between at least one regulation and at least one vulnerability (paragraphs 101 and 108, Williams); testing a target for a vulnerability in the set of vulnerabilities to determine a vulnerability violation (paragraph 0057, Williams); associating a regulation in the set of regulations with the vulnerability violation as a function of the mapping to determine a regulation violation (paragraphs 0062, 0073, Williams).

With respect to claim 2,

Williams discloses the method of claim 1 wherein the regulations are defined by HIPAA (paragraph 0066, Williams).

With respect to claim 3,

Williams discloses the method of claim 1 wherein the regulations are defined by GLBA (paragraph 0066, Williams).

With respect to claim 4,

Williams discloses the method of claim 1 wherein the providing a mapping step further comprises creating a relational database (paragraphs 0053 and 0136 – 0137, Williams).

With respect to claim 5,

Williams discloses the method of claim 4 further comprising: providing a keyword; scanning the set of regulations by the keyword for a keyed regulation; scanning the set of vulnerabilities by the keyword for a keyed vulnerability; grouping the keyed regulation with the keyed vulnerability (paragraphs 0139 and 0141, Williams).

With respect to claim 6,

Williams discloses the method of claim 1 wherein the testing step further comprises scanning a target to provide a system scan (paragraphs 0109, Williams).

With respect to claim 7,

Williams discloses the method of claim 6 further comprising the step of providing a test set as a function of the system scan (paragraphs 0111 – 0112, Williams).

With respect to claim 8,

Williams discloses the method of claim 1 further comprising generating a report including an IP address of the target together with the regulation violation (paragraph 0170, Williams).

With respect to claim 9,

Williams discloses the method of claim 1 further comprising the step of assigning a priority to the regulation violation (paragraph 0160, Williams).

With respect to claim 10,

Williams discloses the method of claim 1 wherein the set of vulnerabilities are defined by CVE (paragraph 0168, Williams).

With respect to claim 11,

Williams discloses a security and vulnerability testing system comprising: a processor (figure 1, Williams); memory operably connected to the processor (figure 1, Williams); wherein the memory contains a program executable by the processor to: search a set of regulations by keyword for a keyed regulation (paragraph 0052, Williams); search a set of vulnerabilities by the keyword for a keyed vulnerability (paragraphs 0139 and 0141, Williams); map the keyed regulation to the keyed vulnerability by the keyword to provide a mapping (paragraphs 101 and 108, Williams); test a target for the keyed vulnerability to determine a vulnerability violation (paragraph 0057, Williams); determine a regulation violation corresponding to the vulnerability violation as a function of the mapping (paragraphs 0062, 0073, Williams).

With respect to claim 12,

Williams discloses the system of claim 10 wherein the regulations are defined by HIPAA (paragraph 0066, Williams).

With respect to claim 13,

Williams discloses the system of claim 10 wherein the regulations are defined by GLBA (paragraph 0066, Williams).

With respect to claim 14,

Williams discloses the system of claim 10 wherein the set of vulnerabilities are defined by CVE (paragraph 0168, Williams).

With respect to claim 15,

Williams discloses the system of claim 10 wherein the program is further executable by the processor to scan a target and determine a corresponding test set (paragraphs 0111 – 0112, Williams).

With respect to claim 16,

Williams discloses the system of claim 10 wherein the program is further executable by the processor to generate a report including an IP address of the target together with the regulation violation (paragraph 0170, Williams).

With respect to claim 17,

Williams discloses a computer-executable process steps, stored on a computer-readable medium and executable by a processor to perform the steps of: search a set

Art Unit: 2166

of regulations by keyword for a keyed regulation (paragraph 0052, Williams); search a set of vulnerabilities by the keyword for a keyed vulnerability (paragraphs 0139 and 0141, Williams); map the keyed regulation to the keyed vulnerability to provide a mapping (paragraphs 101 and 108, Williams); test a target for the keyed vulnerability to determine a vulnerability violation (paragraph 0057, Williams); determine a regulation violation by the keyed vulnerability as a function of the mapping (paragraphs 0062, 0073, Williams).

With respect to claim 18,

Williams discloses the steps of claim 17 wherein the regulations are defined by HIPAA (paragraph 0066, Williams).

With respect to claim 19,

Williams discloses the steps of claim 17 wherein the regulations are defined by GLBA (paragraph 0066, Williams).

With respect to claim 20,

Williams discloses the steps of claim 17 wherein the set of vulnerabilities are defined by CVE (paragraph 0168, Williams).

With respect to claim 21,



Art Unit: 2166

Williams discloses the steps of claim 17 further executable by the processor to scan a target and determine a corresponding test set (paragraphs 0111 – 0112, Williams).

With respect to claim 22,

Williams discloses the steps of claim 17 further executable by the processor to generate a report including an IP address of the target together with the regulation violation (paragraph 0170, Williams).

With respect to claim 23,

Williams discloses the steps of claim 17 further executable by the processor to assign a priority to the regulation violation (paragraph 0160, Williams).

**Contact Information**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navneet K. Ahluwalia whose telephone number is 571-272-5636. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam T. Hosain can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Navneet*

Navneet K. Ahluwalia  
Examiner  
Art Unit 2166

  
MOHAMMAD ALI  
PRIMARY EXAMINER

Dated: 08/18/2006